

Remarks

Applicant has carefully reviewed the application in light of the February 5, 2008 Office Action. In order to advance prosecution, Applicant has amended claim 21 to clarify the subject matter recited therein. Applicant submits, however, that no narrowing of claim scope has occurred. For at least the reasons below, Applicant submits that the currently pending claims are allowable of the cited patent literature. Applicant therefore requests favorable action for this case.

§ 101 Rejections

The Examiner rejects claims 21-29 under 35 U.S.C. § 101 for not being directed to statutory subject matter. Detailed Action ¶ 1. According to the Examiner, the term “article” is not definite in regards to what actually constitutes an article and, hence, could be a computer program. *Id.*

Applicant has amended claim 21 in order to improve the clarity of “article.” As is clearly evident from amended claim 21, an “article” is a manufactured element that includes a machine-readable medium having instructions operable to cause one or more machines to perform operations. Thus, an “article” is a physical element. Moreover, an “article” includes a machine-readable medium having instructions operable to cause a machine to perform operations, which is itself statutory subject matter. M.P.E.P. § 2106.01. Because an “article” is a physical element that includes statutory subject matter, Applicant submits that it is also statutory subject matter.

§ 103 Rejections

The Examiner rejects claims 1-33 under 35 U.S.C. § 103(a) for being obvious in view of U.S. Patent No. 6,437,876 issued to Phang et al. ("Phang") and U.S. Patent Pub. No. 2003/0112462 naming Ochiai as the inventor ("Ochiai"). Detailed Action ¶ 2. Applicant disagrees.

To render a claim obvious under § 103 based on a combination of references, an Examiner must establish that the references or the knowledge generally available to one skilled in the art teach or suggest a logical reason for combining the references, that there is a reasonable expectation of success in making the combination, and that the combined references teach or suggest all of the claim's limitations. M.P.E.P. § 2143. Furthermore, the combination cannot alter the principle of operation of a reference. *Id.* The cited patent literature, however, fails to teach or suggest all of the limitations in any of claims 1-33.

Claim 1 is an independent claim containing limitations not taught by the attempted combination of Phang and Ochiai. Claim 1 recites:

A method comprising:

- receiving document data for printing a document from an application;
- accessing information associated with a sender of the document data; and
- formatting a page to be printed such that the page comprises at least a portion of the received document data and the accessed information, and the accessed information is located between document margins and printer allowable margins.

Nowhere, however, does Phang or Ochiai teach "formatting a page to be printed such that the page comprises at least a portion of the received document data and the accessed information, and the accessed information is located between document margins and printer allowable margins." The Examiner attempts to rely on headers/footers in Phang, which describes techniques for image scaling during printing, to teach accessed information located between document margins and printer allowable margins. Detailed Action ¶ 2. But the Examiner overlooks Phang's disclosure that headers/footers are part of a document. col. 1, ll. 40-54. Thus, Phang lacks any description of "accessed information", much less accessed information "located between document margins and

printer allowable margins.” Ochiai is also deficient because it describes printing user identification information and page information on a back surface of sheet. Abstract; Summary; Fig. 6. For at least these reasons, Applicant submits that Phang and Ochiai fail to teach or suggest the limitations of claim 1. Applicant therefore requests the Examiner to withdraw the § 103 rejection of this claim.

Claim 2-13 depend from claim 1 and, hence, contain all of its limitations, which have already been shown to distinguish over the attempted combination of Phang and Ochiai. Claims 2-13 also contain additional limitations that neither Phang nor Ochiai teaches or suggests.

Claim 2, for example, recites “receiving a request to format information associated with a sender of document data; and generating a user interface that allows formatting of information associated with a sender of document data.” Nowhere, however, does Phang or Ochiai teach such limitations. Applicant notes the Examiner’s assertions to the contrary regarding Phang, but the portions of Phang on which the Examiner relies merely describe software routines (e.g., an application 4, a graphical device interface 10, and a print driver 8) that communicate with each other to carry out a print job, col. 8, l. 59 – col. 4, l. 10, and an application 4 providing an interface for a user to select whether an image should be scaled according to the printable area of a medium, col. 5, ll. 38-55. These fail to teach “receiving a request to format information associated with a sender of document data” or “generating a user interface that allows formatting of information associated with a sender of document data.”

As another example, claim 3 specifies that “the user interface allows specification of the orientation of information associated with a sender of document data.” Nowhere, however, does Phang or Ochiai teach such limitations. Applicant notes the Examiner’s assertions to the contrary regarding Phang, but the portion of Phang on which the Examiner relies merely describes an application 4 providing an interface for a user to select whether an image should be scaled according to the printable area of a medium, col. 5, ll. 38-55.

As a further example, claim 8 recites “initiating an alert if the accessed information for the formatted page does not fit between the document margins and the printer allowable margins.” Nowhere, however, does Phang or Ochiai teach such limitations. Applicant notes the Examiner’s assertions to the contrary regarding Phang, but the portion of Phang on which the Examiner relies merely describes that a user will be warned if the margins of a work exceed the margins of a printer. col. 2, ll. 23-35. This fails to even remotely suggest “initiating an alert if the accessed information for the formatted page does not fit between the document margins and the printer allowable margins.”

As another example, claim 12 specifies that “accessing information associated with a sender of the document data comprises querying a database comprising sender associated information.” Nowhere, however, does Phang or Ochiai teach such limitations. Applicant notes the Examiner’s assertions to the contrary regarding Ochiai, but the portion of Ochiai on which the Examiner relies at best describes that a user identification information generator section 43 generates and temporarily stores user identification information data and a control/driver circuit section 36 controls a printer engine based, among other things, on the user identification information data stored in the user identification information generator section 43. ¶¶ 31-33. This fails to teach or suggest “querying a database comprising sender associated information.”

For at least these reasons, and for the reasons given with respect to claim 1, Applicant submits that the attempted combination of Phang and Ochiai fails to teach or suggest the limitations of claims 2-13. Applicant therefore requests the Examiner to withdraw the § 103 rejections of these claims.

Claim 14 is another independent claim, and contains limitations analogous to those of claim 1. For at least the reasons discussed with respect to claim 1 therefore, Applicant submits that claim 14 also contains limitations that distinguish over the attempted combination of Phang and Ochiai.

Claims 15-20 depend from claim 14 and, hence, contain all of its limitations, which have already been shown to distinguish over the attempted combination of Phang and Ochiai. For at least the reasons given with respect to claims 2-13, claims 15-20 also contain additional limitations not taught by the attempted combination of Phang and Ochiai. For at least these reasons, Applicant submits that claims 15-20 are distinguishable over Phang and Ochiai.

Claim 21 is another independent claim containing limitations analogous to those of claim 1. For at least the reasons discussed with respect to claim 1 therefore, Applicant submits that claim 21 also contains limitations that distinguish over the attempted combination of Phang and Ochiai.

Claims 22-29 depend from claim 21 and, hence, contain all of its limitations, which have already been shown to distinguish over the attempted combination of Phang and Ochiai. For at least the reasons given with respect to claims 2-13, claims 22-29 also contain additional limitations not taught by the attempted combination of Phang and Ochiai. For at least these reasons, Applicant submits that claims 22-29 are distinguishable over Phang and Ochiai.

Claim 30 is another independent claim containing limitations analogous to those of claim 1. For at least the reasons discussed with respect to claim 1 therefore, Applicant submits that claim 30 also contains limitations that distinguish over the attempted combination of Phang and Ochiai.

Claims 31-32 depend from claim 30 and, hence, contain all of its limitations, which have already been shown to distinguish over the attempted combination of Phang and Ochiai. For at least the reasons given with respect to claims 2-13, claims 31-32 also contain additional limitations not taught by the attempted combination of Phang and Ochiai. For at least these reasons, Applicant submits that claims 31-32 are distinguishable over Phang and Ochiai.

Claim 33 is another independent claim containing limitations analogous to those of claim 1. Claim 33 contains limitations analogous to those of claims 1, 3, 8, and 12.

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For at least the reasons discussed with respect those claims therefore, Applicant submits that claim 33 also contains limitations that distinguish over the attempted combination of Phang and Ochiai.

Conclusion


Applicant submits that a good faith effort has been made to advance the prosecution of this application and that the application is allowable over the rejections expressed in the Office Action. Applicant therefore requests favorable action for this case. If, however, any issues exist that may be advanced by telephone conference, Applicant requests that the Examiner contact its below-listed attorney.

Applicant believes that all of the Examiner's objections and rejections to the application have been addressed. Thus, Applicant's failure to address any objections or rejections should not be taken as acquiescence to any finding of the Examiner. Moreover, Applicant's arguments herein against the Examiner's findings should not be construed as Applicant's only basis for countering the findings. Applicant has made these arguments to illustrate the errors in the Examiner's findings and to expeditiously move the case forward.

Applicant does not believe that this paper requires any adjustment in fees. If, however, applicant is mistaken, please apply any charges or credits to deposit account 05-0765.

Respectfully submitted,

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